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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/623,734

07/22/2003

Hiroshi Nishikawa

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EXAMINER

JOERGER, KAITLIN S

ART UNIT

PAPER NUMBER

3653

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/23/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/623,734

Applicant(s)

NISHIKAWA ET AL.

Examiner

Kaitlin S. Joerger

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/22/03 4/21/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asada et al. (U.S. Patent 5,584,475).

Regarding claim 1, Asada et al. teaches an for transporting sheets into a fixed image reading position, comprising:

a drive roller, 4; and

a pad having a lower layer, 45, made of a flexible material, see column 5, line 49 through column 6, line 24, and an upper layer, 26, provided on the lower layer and made of rigid material in the form of film with a kinetic friction coefficient of 0.2 or less, see column 5, lines 53-56, the pad being biased to the drive roller so that the upper layer contacts a peripheral surface of the drive roller to form a nipping region between the drive roller and the pad by a compressive deformation of the flexible lower layer of the pad, see figures 4 and 6.

Asada et al. does not specifically teach that the kinetic coefficient of friction of the upper layer is .2 or less, however Asada et al. does teach a low coefficient of friction for the upper layer, 26. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an upper layer in the apparatus taught by Asada et al. with a coefficient of friction of .02 or less, since it has been held that where the general conditions of a

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claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claim 2, Asada et al. teach a flexible lower layer, 45, however Asada et al. does not teach that the lower layer has a compressive residual strain of 10% or less. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a lower layer in the apparatus taught by Asada et al. with a compressive residual strain of 10% or less, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claim 6, Asada et al. teaches that the pad is biased toward the drive roller by a spring, 40.

Regarding claim 7, Asada et al. teaches an apparatus for transporting sheets into a fixed image reading position, comprising:

- a drive roller, 4;

- a pad having a rigid backup portion, 5, a lower layer, 45, made of a flexible material and an upper layer, 26, provided on the lower layer and made of rigid material in the form of film with a kinetic friction coefficient of 0.2 or less;

- and a spring, 40, which biases the pad to the drive roller so that the upper layer contacts a peripheral surface of the drive roller to form a nipping region between the drive roller and the pad by a compressive deformation of the flexible lower layer of the pad.

Asada et al. does not specifically teach that the kinetic coefficient of friction of the upper layer is .2 or less, however Asada et al. does teach a low coefficient of friction for the upper

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layer, 26. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an upper layer in the apparatus taught by Asada et al. with a coefficient of friction of .02 or less, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asada et al. in view of Nakamura et al.

Regarding claim 3, Asada et al. teaches all the features of the claimed invention except for the feature that the upper layer of the pad is made of an electrically conductive material, but Nakamura et al. does teach this feature. Nakamura et al. teaches a separation pad with an upper layer, 33g, made of an electrically conductive material, see figure 29 and column 8, line 4+, for the purpose of converting a change in thickness of an original into an electrical signal, for the purpose of detecting a multi-pick, see abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use electrically conductive material in the apparatus of Asada et al. as taught by Nakamura et al. for the purpose of converting a change in thickness of an original into an electrical signal, for the purpose of detecting a multi-pick.

Regarding claim 4, Asada et al. teaches all the features of the claimed invention except for the feature that the lower layer of the pad is made of an electrically conductive material, but Nakamura et al. does teach this feature. Nakamura et al. teaches a separation pad with a lower layer, 33a, made of an electrically conductive material, see figure 29 and column 8, line 4+, for the purpose of converting a change in thickness of an original into an electrical signal, for the

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purpose of detecting a multi-pick, see abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use electrically conductive material in the apparatus of Asada et al. as taught by Nakamura et al. for the purpose of converting a change in thickness of an original into an electrical signal, for the purpose of detecting a multi-pick.


Regarding claim 5, Asada et al. teaches all the features of the claimed invention except the feature wherein an electrostatic charge generated by a contact the upper layer with the sheet is discharged through the lower layer, but Nakamura et al. does teach this feature, see column 8, lines 4+, for the purpose of converting a change in thickness of an original into an electrical signal, for the purpose of detecting a multi-pick, see abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use electrically conductive material in the apparatus of Asada et al. as taught by Nakamura et al. for the purpose of converting a change in thickness of an original into an electrical signal, for the purpose of detecting a multi-pick.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaitlin S. Joerger whose telephone number is 571-272-6938. The examiner can normally be reached on Monday - Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on 571-272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Kaitlin S Joerger
Examiner
Art Unit 3653

15 February 2007